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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,276	06/12/2006	Masayoshi Son	285301US2XPCT	5677

22850 7590 09/03/2008  
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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LAEKEMARIAM, YOSEF K

ART UNIT	PAPER NUMBER
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2614

NOTIFICATION DATE	DELIVERY MODE
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09/03/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/566,276	<b>Applicant(s)</b> SON, MASAYOSHI	
	<b>Examiner</b> YOSEF K. LAEKEMARIAM	<b>Art Unit</b> 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7 and 9-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/30/2006, 06/04/2008</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 2614

***Response to Arguments***

1. Applicant's arguments with respect to claims 1-2, 4-7, 9-12 have been considered but are moot in view of the new ground(s) of rejection (see the rejection below).

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S Code not included in this action can be found in a prior office action.

2. Claims 1-2, 4-7, 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forte et al. (US 7,162,020) in view of Taylor et al. (WO/1998/036551).

Regarding claim 1, Forte discloses a gateway device to be installed between a public telephone network and a private branch exchange (Col.2 lines 56-61) to which a plurality of extension telephones are connected, said gateway device (Col.6 lines 11-14), comprising: a public telephone network connection unit (Col.12 lines 10-16; Forte discusses network switching device, therefore network connection unit) configured to connect the extension telephones to said public telephone network through said private branch exchange (Col.4 lines 17-26 and Col.12 lines 7-17); an Internet connection unit configured to connect said private branch exchange to the Internet (abstract lines 3-6 and Col.2 lines 58-66; Forte discusses a wireless connect unit which connect PBX to PSTN, therefore an internet connection unit); a connection switching unit configured to selectively connect either said public telephone network or the Internet to said private branch exchange (Col.4 lines 21-31 and Col.12 lines 11-21; Forte discusses network switching device and suitable communication line, therefore connection switching unit); a

Art Unit: 2614

detecting unit configured to detect the use condition of a communication line connected to said private branch exchange (Col.6 lines 49-63, Col.7 lines 3-20 and Col.8 lines 54-60; Forte discusses WC 230, therefore a detecting unit); A notification unit configured to transmit, to said public telephone network through said public telephone network communication unit (Col.6 lines 1-10), wherein said private branch exchange is configured to switchingly connect the plurality of extension telephones with a plurality of communication lines of said public telephone network (Col.12 lines 6-22 and fig.1, 12a-12b, 14), wherein said gateway device is provided for each of the plurality of communication lines of said public telephone network (Col.2 lines 56-63), and wherein, when the communication line connected to said private branch exchange through said gateway device is in use (Col.4 lines 17-34 and Col.8 lines 46-59), a different gateway device serves to make a connection by proxy in response to a connection request issued for said gateway device in accordance with said notification unit (Col.2 lines 54-61) .

Forte discloses the invention set forth above except for the claimed “an outgoing call only setting signal which notifies said public telephone network that only calling is viable to said public telephone network and to inform said public telephone network that an incoming call cannot be responded, only outgoing calling being viable in a case where the communication line connected to said private branch exchange is in use”

Taylor discloses that it is well known to have an outgoing call only setting signal which notifies said public telephone network that only calling is viable to said public telephone network and to inform said public telephone network that an incoming call cannot be responded, only outgoing calling being viable in a case where the communication line connected to said private branch exchange is in use (Paragraphs (In detail description): 18-20).

Art Unit: 2614

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Forte, and modify that outgoing call only setting signal which notifies said public telephone network that only calling is viable to said public telephone network and to inform said public telephone network that an incoming call cannot be responded, as taught by Taylor, thus allowing more efficient method for setting signal to notify public telephone network, as discussed by Taylor.

Regarding claims 6 and 11, Forte discloses a private branch exchange system configured to switchingly connect between a public telephone network and a plurality of extension telephones, said private branch exchange system (abstract lines 3-12, Col.4 lines 1-11 and Fig.1, 12a, 12b, 16), comprising: a private branch exchange connected to the plurality of extension telephones (Fig.1, 12a-12b, 14) and configured to switchingly connect the plurality of extension telephones with a plurality of communication lines of said public telephone network (Col.4 lines 38-57 and Col.12 lines 23-32); and a plurality of gateway devices provided for the plurality of communication lines of said public telephone network respectively (Col.2 lines 56-63), and configured to connect the extension telephones to said public telephones network through said private branch exchange (Col.4 lines 17-28), each of said gateway devices comprising: a public telephone network connection unit (Fig.1; 34, 36, 54) configured to connect said an extension telephone to said public telephone network (Col.4 lines 17-28 and Col.6 lines 16-35; Forte discusses office extension numbers, therefore extension telephone); through said private branch exchange; an Internet connection unit (Fig.3, 14) configured to connect said extension telephone to the Internet (Col.4 lines 21-29 and Fig.3 12a, 12b, and 50) internet through said private branch exchange; a connection switching unit (Col.6 lines 48-53 and Fig.3, 229) configured to

Art Unit: 2614

selectively connect either said public telephone network or the Internet (Fig.3 16, 50 and 230) to said extension telephone (Col.4 lines 1-5 and Fig.3 12a, 12b, 16, 50); a detecting unit (Col.8 lines 46-59; Forte discusses WC 230, therefore a detecting unit) configured to detect a use condition of a communication line connected to said extension telephone (Col.8 lines 54-65; Forte discusses line port detecting activity of a call, therefore detecting use condition of a line); a notification unit configured to transmit, to said public telephone network through said public telephone network connection unit (Col.6 lines 1-10), a different gateway device serves to make a connection by proxy in response to a connection request issued for said one of said gateway devices in accordance with said notification unit (Col.2 lines 54-61) .

Forte discloses the invention set forth above except for the claimed “an outgoing call only setting signal which notifies said public telephone network that only calling is viable to said public telephone network and to inform said public telephone network that an incoming call cannot be responded, only outgoing calling being viable in a case where the communication line connected to said extension telephone is in use, wherein, when the communication line connected to said public telephone network through said private branch exchange of one of said gateway devices is in use”

Taylor discloses that it is well known to have an outgoing call only setting signal which notifies said public telephone network that only calling is viable to said public telephone network and to inform said public telephone network that an incoming call cannot be responded, only outgoing calling being viable in a case where the communication line connected to said extension telephone is in use, wherein, when the communication line connected to said public

Art Unit: 2614

telephone network through said private branch exchange of one of said gateway devices is in use (Paragraphs (In detail description): 18-20).

Considering claims 2 and 7, Forte and Taylor together discloses the apparatus and system as defined in claim 1 and 6, Taylor further discusses a system wherein said notification unit notifies said public telephone network that an outgoing call process and an incoming call process are viable when the communication line connected to said private branch exchange comes to be in an unused state (Paragraphs: 19 and 32).

Considering claims 4 and 9, Forte and Taylor together discloses the gateway device as claimed in claim 1, Forte further discloses a system an identifier generation unit configured to generate a caller identifier for identifying the extension telephone (Col.7 lines 3-8; Forte discusses ANI, therefore caller identifier) connected to said public telephone network through said private branch exchange (Fig.3 14) based on a control signal from the extension telephone (Col.7 lines 3-14; Forte discusses guest room extension, therefore extension telephone), and an intended recipient identifier for identifying a communication device of an intended recipient of the extension telephone (Col.7 lines 23-32; Forte discusses database maintains information concerning telephone extension, therefore recipient identifier); a conversion unit configured to perform a conversion between voice signals and packet signals relating to the communication for voice conversation (Col.11 lines 60-67 and Col.12 lines 1-10); and a packet transmitter receiver unit configured to transmit said packet signals to the internet and to receive said packet signals from the Internet based on of said caller identifier and said intended recipient identifier (Col.4 lines 61-67 and Col.5 lines 1-10).

Art Unit: 2614

Considering claims 5 and 10, Forte and Taylor together discloses the gateway device as claimed in claim 4, Forte further discloses a system wherein a determination unit configured to output said voice signals to said public telephone network without the conversion between voice signals and packet signals, depending upon said intended recipient identifier (Col.6 lines 64-67 and Col.7 lines 1-8).

Considering claim 12, Forte and Taylor together discloses the extension telephone switching method as claimed in claim 11, Taylor further discloses a method comprising notifying said public telephone network that an outgoing call process and an incoming call process are viable when the communication line connected to said extension telephone comes to be in an unused state (Paragraph: 19; Taylor discusses determining availability of the resources to accept the incoming call, i.e. extension telephone comes to be in an unused state).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YOSEF K. LAEKEMARIAM whose telephone number is (571) 270-5149. The examiner can normally be reached on Regular hours 8:30am-5:30pm M - F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, AHMAD MATAR can be reached on (571) 272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 2614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/YOSEF K LAEKEMARIAM/  
Examiner, Art Unit 2614  
08-17-2008

/Ahmad F MATAR/  
Supervisory Patent Examiner, Art Unit 2614